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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION N
10/066,408	01/30/2002	Eric T. Easterbrook	SII-2627-U-C5	3734
20793	7590	11/01/2004	EXAMINER	
R REAMS GOODLOE, JR. & R. REAMS GOODLOE, P.S. 24722 104TH. AVENUE S.E. SUITE 102 KENT, WA 98030-5322			CRANE, DANIEL C	
			ART UNIT	PAPER NUMBER
			3725	

DATE MAILED: 11/01/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/066,408

Applicant(s)

EASTERBROOK, ERIC T.

Examiner

Daniel C Crane

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
  - If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
  - If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
  - Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-35,37,38,40 and 46-128 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-15,19-35,37,38,40,46-80 and 108-128 is/are allowed.
- 6) ☒ Claim(s) 16-18 and 81-107 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

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**COMMENT**

In the previous Office Action of February 20, 2004, the Examiner noted that this application included a large number of claims. The Examiner further requested that applicant's attorney review the present claims under consideration so to preclude the claiming of the same inventions and to eliminate any conflicting claimed subject matter from those filed in any of applicant's pending applications and applications now patented. The Examiner also noted that a clear line of demarcation must be maintained between applicant's pending application and applicant's previously filed applications and patents. Applicant's attorney has failed to comply, as evident from the noted double patenting rejection set forth below.

It is again required that applicant's attorney review the claims in this application relative to applicant's previous patents (patent no. 6,230,537, patent no. 6,389,865, patent no. 6,615,636 and patent no. 6,711,928) setting forth the distinctions between every claim.

**DOUBLE PATENTING REJECTION BASIS**

A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The

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filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

### **DOUBLE PATENTING REJECTION**

Claims 81-91 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-11 of prior U.S. Patent No. 6,615,636. This is a double patenting rejection.

Claims 92-107 are rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-16 of prior U.S. Patent No. 6,711,928. This is a double patenting rejection.

### **REJECTION OF CLAIMS OVER PRIOR ART**

Claims 16-18 are rejected under 35 U.S.C. 102(b) as being anticipated by Wong (Canadian document no. 2,121,120). Since Wong uses a preselected amount of pressure (18Kn) in the indenting force to form and impart a residual compressive stress within the surface of the structure, a "preselected amount of residual stress" will be established within the structure. Furthermore, since Wong is concerned with imparting compressive residual stress within the structure to improve the fatigue life of the structure, the residual stress will not be arbitrary and the design of the improved structure will involve a specific indenting force with a specific compressive residual stress to result in an improved structural product. Wong's fatigue improvement process is directed to the aircraft industry and would, thus, inherently foresee the applicability of the indenting process to be for all jointed structures, i.e., the joint between several layered structures. Accordingly, it is clearly inherent that each of the first and second

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members of the structure be provided with the beneficial compressive stresses within all the members.

#### **INDICATION OF ALLOWABLE SUBJECT MATTER**

Claims 1-5, 19-35, 37, 38, 40, 46-80 and 108-128 are allowed.

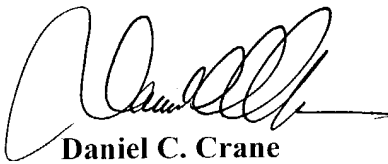
#### **INQUIRIES**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner D. Crane whose telephone number is **(703) 308-1870**. The examiner's office hours are 6:30AM-5:00PM, Tuesday through Friday. The examiner's supervisor, Mr. Allen Ostrager, can be reached at **(703) 308-3136**.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is **(703) 308-1148**.

Documents related to the instant application may be submitted directly to Group 3700 by facsimile transmission at all times. Applicant(s) is(are) reminded to clearly mark any transmission as "DRAFT" if it is not to be considered as an official response. The Group 3725 Facsimile Center number is **(703) 872-9306**.

DCCrane  
October 27, 2004



**Daniel C. Crane**  
Primary Patent Examiner  
Group Art Unit 3725